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Filed : April 14, 2000

REMARKS

In response to the Office Action mailed on December 1, 2004, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following remarks. Claims language 1, 11, 22, 27, 33, 37, and 46 are amended as shown above. No new matter is added by these amendments. Claims 1-3, 5-9, 11-19, 22-33, and 35-55 are currently pending in this application and are presented for further examination.

Discussion of rejecting Claims 1-3, 5-9, 11-19, 22-33, and 35-55 under 35 U.S.C. § 103(a)

Claims 1-3, 5-6, 9, 11-13, 15-17, 22-24, 26, 33, and 35-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over von Rosen et al. (U.S. Patent 6,493,677) in view of Lahey (U.S. Patent 6,384,923), in view of Official Notice and further in view of Meltzer et al. (U.S. Patent 6,125,391). The Office Action rejected Claims 7-8 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Rosen/Lahey/Official Notice/Meltzer and further in view of the webpages “americangreetings.com” as available to the public on November 15, 1999, extracted from <http://www.archive.org> on 8/22/03. Claims 27-30, 32, and 37-41, 45-51, and 55 were rejected under 35 U.S.C. § 103(a) as being obvious over Rosen/Lahey/Official Notice/Meltzer and further in view of Official Notice. Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen/Lahey/Official Notice/Meltzer and further in view of Americangreetings. Claims 27-30, 32, 37-41, 45-51, and 55 are rejected under 35 U.S.C. § 103(a) over Rosen in view of Lahey. Claims 31, 42-43, and 52-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen and Lahey and further in view of Americangreetings. Applicant respectfully traverses these grounds of rejection.

Claims 1, 11, 22, 27, 33, 37, and 46

Claims 1, 11, 22, 27, 33, 37, and 46 were amended to generally indicate that the claims include personalized product systems and methods that include one or more products being associated with the manufacturing capabilities of two or more vendors that are capable of producing the product, and the personalization and processing associated with such products (the foregoing amendments show specific amendments for each of these claims). While the reasons

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for overcoming the rejection of Claim 1 are discussed in detail below, similar reasoning also applies to Claims 11, 22, 33, 37, and 46, which are discussed after the Claim 1 remarks.

Claim 1

The Office Action rejected Claim 1 under 35 U.S.C. § 103(a) asserting that Rosen teaches “a method for facilitating the creation of personalized products...a products database containing information on products available for personalization and further containing *manufacturing capabilities of a plurality of vendors* capable of producing the products available for personalization (see at least abstract, Fig. 2, Fig. 3)...” (*emphasis added*).

The Office Action further asserts that Rosen teaches “each product [in the products database] being associated with different manufacturing capabilities of one or more vendors capable of producing the product see col. 3, line 64-col.4, line 3.”

Amended Claim 1 is a method for facilitating the creation of personalized products, where a selectable product is associated with the manufacturing capabilities of two or more vendors each capable of producing the product. For example, the amendments to Claim 1 include:

“providing to the user via said communication network at least one web page providing an assortment of product selections for products in the products database, where one or more products available in the products database are associated with manufacturing capabilities of two or more vendors, from the plurality of vendors, capable of producing the product;

receiving a message from the user via said communication network indicating a selection of a selected product from said assortment of product selections, the selected product being associated with manufacturing capabilities of two or more vendors capable of producing the product;” (*emphasis added*).

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *See* M.P.E.P § 2143.03. After a careful review of the referenced art, Applicant respectfully submits that Rosen and the other cited art fail to disclose these required elements of amended Claim 1. Rosen fails to mention the possibility of having two vendors, and Rosen fails to disclose, teach or suggest that “one or more products available in the products database are associated with manufacturing capabilities of two or more vendors...” or that “the selected product being associated with manufacturing capabilities of two or more vendors capable of producing the product;” (amended Claim 1). The Rosen invention is directed

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to system where a consumer uses a website associated with a merchant (i.e., vendor) to order a personalized product (see Rosen Figures 6-11B, and discussion of same beginning on Col. 8, line 61). Applicant notes that the address of the web site is associated with the product being customized, and that the routine described in Fig. 12 includes no opportunity to choose a vendor. In fact, Rosen fails to describe or suggest how more than one vendor could participate to sell merchandise or receive payments in its merchandise system. Instead, Rosen discloses a system for a WWW site where a single merchant sells merchandise, for example, describing its billing system to include a credit card processor that “may transmit the information to banking institution 38 to debit funds from an account associated with consumer 30 and to transfer the funds into an account associated with *the merchant* operating the WWW server” (*emphasis added*). Col. 5, lines 27-31.

Regarding disclosing each product being associated with different manufacturing capabilities of multiple (e.g., two or more) vendors, the Office Action (page 4) states

“Those skilled in the art should appreciate that although laser printer 46 comprises a color laser printer in the illustrative embodiment, other types of printers may be used. For instance, special purpose printers may be used to create customized products such as t-shirts, cups, billboards, etc.’ [Rosen, Figure 2, and Col. 5, lines 48-53]. Note: In order to create customized products other than soda bottle, such as t-shirts, cups and billboards represent products and their capabilities of one or more vendors because one vendor may be suitable for supplying t-shirts, another for cups and still another for billboards, and so on.”

Applicant respectfully submits that here Rosen merely discloses that a single merchant may have several types of printers 46 instead of the single laser printer illustrated in Figure 2. An interpretation that Rosen makes obvious a personalized product system that uses the manufacturing capabilities of multiple vendors merely from the disclosure of the possibility of multiple types of printers is, at best, hindsight, which is impermissible. Furthermore, while it may be true that different products may require different vendors, Rosen fails to disclose, suggest or teach that using is necessary or even optional for its invention. Moreover, even if a different vendor was required for each product in Rosen, having a system where “one or more products available in the products database are associated with manufacturing capabilities of two or more vendors” is never disclosed, suggested or taught in Rosen.

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The Office Action admits “Rosen does not teach selecting a vendor from the plurality of vendors being capable of producing the selected product personalized with the set of design configuration selections and the set of individualized enhancements.” However, in asserting this element of Claim 1 is obvious, the Office Action combines Rosen with the Official Notice of the fact that in the business of selling, a vendor is selected from the plurality of vendors available to produce the product.

To establish a *prima facie* showing of obviousness, the Patent and Trademark Office has the burden to provide a motivation, teaching, or suggestion to create the claimed invention. *See, e.g., In re Fine*, 5 U.S.P.Q.2d 1597 (Fed. Cir. 1988). Moreover, the evidence to prove the motivation, teaching, or suggestion must be clear and particular and can flow from one of only three sources: (1) the prior art references themselves, (2) the knowledge of one of ordinary skill in the art, or (3) the nature of the problem to be solved. *See, In re Dembiczkak*, 175 F.3d 994, 999 (Fed Cir. 1999).

This element of Claim 1 was amended herein to now include “selecting a vendor from the two or more vendors, the selected vendor being capable of producing the selected product personalized with the set of design configuration selections and the set of individualized enhancements.” Applicant respectfully submits that the Office Action has not shown a clear and particular motivation, teaching or suggestion in the referenced art to combine Rosen with the Official Notice. The Rosen references itself does not disclose a motivation to combine with the Official Notice to select a vendor from two or more vendors because, as discussed above, Rosen fails to disclose, teach or suggest a system or method where two vendors are capable of producing the same product, nor does Rosen incorporate the benefit of having two vendors capable of producing the same product (e.g., different capabilities of personalization criteria for the same product). There is no reason to select a vendor in Rosen because Rosen discloses a personalized system configured to use a single vendor for a product (as discussed above), and therefore one of ordinary skill in the art would not be motivated to combine Rosen with the Official Notice. Also, the motivation, teaching or suggestion would not flow from the knowledge of one of ordinary skill in the art because the combination does not address any problem to be solved in Rosen. The mere fact that Rosen could be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

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modification, which it does not in this case. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections because all elements of Claim 1 are not taught or suggested by the referenced art, and because there is no motivation to combine Rosen with the Official Notice. Applicant submits that Claim 1 is thereby in condition for allowance.

Claims 2-3, and 5-9

As Claims 2-3 and 5-9 are dependent directly or indirectly on the above-discussed independent Claim 1, Applicant respectfully submits that Claims 2-3 and 5-9 are also in condition for allowance for at least the same reasons and requests withdrawal of the 35 U.S.C. § 103(a) rejection.

Claims 11, 22, 27, 33, 37, and 46

The Office Action rejected Claims 11, 22, 27, 33, 37, and 46 based on Rosen as the main reference. Rosen and the other cited art at least fail to disclose the required elements of Amended Claims 11, 22, 27, 33, 37, and 46 as discussed above for Claim 1. For example, some required elements of Claims 11, 22, 27, 33, 37, and 46 are as follows:

Amended Claim 11 includes:

“retrieving a set of manufacturing capabilities for the selected product from the products database, the set of manufacturing capabilities including the manufacturing capabilities of two or more vendors, from a plurality of vendors, capable of producing the selected product;

providing to the user via said communication network a design interface, said design interface comprising at least one design tool that allows the user to select product configuration options and to create individualized enhancements, and wherein said design tool is adapted so that the user may only select configuration options and create enhancements which comply with said manufacturing capabilities of at least one of the two or more vendors capable of producing the selected product;”

Amended Claim 22 includes:

“retrieving a set of manufacturing capabilities for the selected product, the set of manufacturing capabilities including the manufacturing capabilities of two or more vendors, from a plurality of vendors, capable of producing the selected second product;

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selecting a vendor from the two or more vendors of the plurality of vendors, the selected vendor being capable of producing the selected product with the set of product configuration options and set of individualized enhancements;”

Amended Claim 27 includes:

“retrieving a set of manufacturing capabilities for the selected product from a products database, the set of manufacturing capabilities comprising the manufacturing capabilities of two or more vendors from a plurality of vendors capable of producing the selected product;”

Amended Claim 33 includes:

“receiving a design interface from a host merchant via said communication network, said design interface comprising at least one web page including at least one design tool that allows the user to select product configuration options and to create individualized enhancements, and wherein said design tool is conformed to only allow configuration options and enhancements which satisfy said manufacturing capabilities associated with two or more vendors, from the plurality of vendors, capable of producing the products and to initially present a set of default design components associated with said selected product; and ...

selecting a vendor from the two or more vendors capable of producing the selected product personalized with the set of product configuration options and the at least one individualized enhancement;”

Amended Claim 37 includes:

“a products database in communication with said server, said products database comprising information on one or more products available for personalization, and further comprising manufacturing capabilities of two or more vendors, from a plurality of vendors, capable of creating the one or more products;

a set of design tools in communication with said personalized product module that allow the user to select product configuration options and create individualized enhancements, wherein said set of design tools is adaptable to only accept product configuration selections and individualized enhancements which comply with a set of manufacturing capabilities that includes the manufacturing capabilities of the two or more vendors from the plurality of vendors capable of creating the selected product;”

Amended Claim 46 includes:

a products database comprising information on an assortment of products available for personalization, and further comprising for one or more products of the assortment of products, manufacturing capabilities of two or more vendors, from a plurality of vendors, capable of creating the product;

a second module in communication with said first module, said second module comprising at least one design tool that allows the user to select product configuration options and create individualized enhancements, wherein said design tool is adaptable to

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only accept product configuration selections and individualized enhancements which comply with a set of manufacturing capabilities associated with the two or more vendors capable of creating the selected product;

As discussed above for Claim 1, Rosen and the other cited art fails to disclose, teach or suggest a system that personalizes a product that can be made by two or more vendors, as specifically required in the above cited claim elements. Therefore, Applicant respectfully submits that all elements of Claims 11, 22, 27, 33, 37, and 46 are not taught by the referenced art. Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections of Claims 11, 22, 27, 33, 37, and 46 and submits that these claims are thereby in condition for allowance.

Claims 12-19, 23-26, 28-32, 33, 35-36, 38-45, and 47-55

As Claims 12-19, 23-26, 28-32, 33, 35-36, 38-45, and 47-55 are dependent directly or indirectly on the above-discussed independent Claims 11, 22, 27, 33, 37, and 46, Applicant respectfully submits that Claims 12-19, 23-26, 28-32, 33, 35-36, 38-45, and 47-55 are also in condition for allowance for at least the same reasons and requests withdrawal of the 35 U.S.C. § 103(a) rejections.

CONCLUSION

The applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory section 103, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply

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additional specific statements of inventive concepts described in the application as originally filed.

If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned at (619) 687-8610.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

Dated: May 2, 2005

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